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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,554	01/02/2002	Giuseppe Caputo	9065-11	3035
20792	7590	08/25/2003		
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627			EXAMINER STOCKTON, LAURA	
			ART UNIT 1626	PAPER NUMBER
				DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,554	CAPUTO ET AL.	
	Examiner	Art Unit	
	Laura L. Stockton, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 June 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 7 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>8/20/03</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1/2/02</u>
<u>5/16/02</u>
<u>5/10/02</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claims 1-5 and 7 are pending in the application.

Election/Restrictions

Applicants' election without traverse of Group III in the response filed April 21, 2003 is acknowledged. In a telephonic interview on August 20, 2003, Applicants elected the species of Example 9.

The requirement is still deemed proper and is therefore made FINAL.

Subject matter not embraced by elected Group III is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions. Election was made **without** traverse in the response filed April 21, 2003.

It is suggested that in order to advance prosecution, the non-elected subject matter be cancelled when responding to this Office Action.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by:

- a) CAS Registry No. 179028-63-3 (August 2, 1996);
- b) CAS Registry No. 173536-26-0 (February 27, 1996);
- c) Gallaher et al. {Anal. Chem., 2000, 72(9), pages 2080-2086}
 - see the compound labelled NIR tag on page 2082;
- d) Gallaher et al. {Analyst (Cambridge, United Kingdom) (1999), 124(11), pages 1541-1546} – see compound (4) in Scheme 1 on page 1542;
- e) Bosies et al. {CA 2315207} – see, for example, compound 2 on page 15;
- f) Flanagan, Jr. {Bioconjugate Chemistry (1997), 8(5), pages 751-756} – see, for example, compound 3 on page 751;
- g) Houthoff et al. {WO 96/35696} – see, for example, the compound labeled IRD on page 18;
- h) Fabricius et al. {U.S. Pat. 5,519,145} – see, for example, D9 in Table 1 on columns 19-20;

- i) Harada et al. {JP 06-145539 – an English translation provided} - see, for example, compound 1 in paragraph [0020] of the English translation;
- j) Lipowska et al. {Synthetic Communications (1993), 23(21), pages 3087-3094} – see, for example, compound 6 on page 3088;
- k) Strekowski et al. {Journal of Organic Chemistry (1992), 57(17), pages 4578-4580} – see compound 2e on page 4579; and
- l) Muehlegger et al. {JP 11-286498 – an English translation provided} – see the compound of CAS Registry No. 167847-81-6.

Each of the above cited prior art disclose at least one compound which is embraced by the instant claimed invention.

Claims 1-5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Frangioni {WO 02/38190} and Narayanan {U.S. Pat. 6,593,148}, each taken alone.

Frangioni discloses compound I in Figure 1 (page 1/7) which is embraced by the instant elected invention.

Narayanan discloses compound 3A in columns 21 and 22 which is embraced by the instant claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabricius et al. {U.S. Pat. 5,519,145} and Narayanan {U.S. Pat. 6,593,148}, each taken alone.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim cyanine dye compounds. Fabricius et al. (columns 3 and 4; or compound D9 in Table 1 on columns 19-20) and Narayanan (columns 4 and 5; or compound 3A in columns 21 and 22) each teach cyanine dye compounds that are either structurally the same as (see above 102 rejection) or structurally similar to the instant claimed compounds.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of “some” among “many” is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., an antihalation dye).

One skilled in the art would thus be motivated to prepare compounds embraced by the prior art to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful, for example, as an antihalation dye in a photographic element. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Allowable Subject Matter

The elected species of Example 9 is allowable over the art of record.

The USPTO is participating in a search exchange pilot program with the European Patent Office (EPO). As part of the pilot program, the USPTO has received a copy of the Search Report prepared by the EPO on the counterpart EP application for which priority under 35 U.S.C. 119(a) is claimed. The references cited in the EPO Search Report have been considered by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Laura L. Stockton
Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

August 22, 2003